

REMARKS

This Amendment is being filed concurrently with a RCE. Claims 1 and 5-9 are pending in this application. By this Amendment, claim 1 is amended and claims 2-4 and 10-18 are canceled. The amendments to claim 1 are supported in the application as originally filed at page 22, line 6 - page 23, line 2; and at Figs. 2(a) and 2(b). No new matter is added. In view of at least the following remarks, reconsideration and allowance are respectfully requested.

Claims 1 and 5-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 57-132051 to Yasuyuki ("Yasuyuki") in view of Japanese Patent Publication No. 04-015122 to Nissan Motor Co. Ltd. ("Nissan"). This rejection is respectfully traversed.

The applied references fail to support a *prima facie* case of obviousness because, even combined, the references fail to disclose or suggest a mount apparatus for a variable compression ratio internal combustion engine including a first mount portion provided on a transmission apparatus, a second mount portion provided on a crankcase, and where "the variable compression ratio internal combustion engine is mounted on the vehicle body member such that the cylinder block moves relative to the vehicle body member a greater distance than the crankcase moves relative to the vehicle body member when the compression ratio is varied," as recited in claim 1.

The Office Action alleges that Fig. 3 of Nissan discloses mounts 40 provided on a crankcase 36 and transmission 39. Accordingly, the Office Action suggests it would have been obvious to one of ordinary skill in the art to mount the engine in Yasuyuki with the mount structure of Nissan. However, Nissan also teaches that in order to "improve the effective damping and realize a light weight" the cylinder block should be supported on the vehicle subframe on elastic mounts that are provided all around the cylinder block. See

Abstract of Nissan. As further stated in Nissan, "elastic bodies 7 connected all around the cylinder block are provided at its lower surface, and at the same time the support of the cylinder block 1 is made on a vehicle subframe 8 through elastic bodies 7." See Abstract of Nissan. Thus, regardless of additional structure disclosed in Fig. 3 of Nissan (such as items 40), Nissan teaches that in order to achieve the advantages of improving damping and realizing a light weight construction, the cylinder block should be supported on the vehicle frame. Thus, even if the references are combined, the cylinder block would not move relative to the vehicle body member at a greater distance than the crankcase when the compression ratio is varied because, as stated in Nissan, "the cylinder block 1 is supported by utilizing the subframe 8 which is of high rigidity."

The 35 U.S.C. §103 rejection is also improper because a person of ordinary skill in the art would not have been motivated to make the combination of Yasuyuki and Nissan, as alleged by the Examiner. Regarding the motivation to combine the references, the Office Action states on pages 2 and 3 that "the Examiner contends that all engines require mounting structure, and because JP '051 lacks any teaching of what mounting structure to use, one of ordinary skill in the art would be forced to look elsewhere. There is nothing in the mounting arrangement of JP '122 that precludes its use with a variable compression engine and while a fixed compression ratio engine is shown; and so, both references would suggest the combination. In addition, JP '122 does indicate that the support structure for the engine would result in weight savings."

However, it is well settled that the mere fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. See MPEP §2143.01(III). Additionally, the motivation cited in the Office Action that the engine would result in weight savings, is not attributable to the mounting structure allegedly illustrated in items 40 in Fig. 3 of Nissan, but rather to the elastic bodies used to mount the cylinder block

to the vehicle subframe. See Abstract of Nissan. In this regard, even if Nissan discloses mountings on the crankcase at 40, it also requires mounting on the cylinder block; such a configuration is not suitable for a variable compression ratio engine that requires relative movement between the cylinder block and the crankcase. Accordingly, the Office Action has failed to provide explicit "articulated reasoning with a rational underpinning" to support its legal conclusion of obviousness. KSR, Int'l. Co. v. Teleflex, Inc., No. 04-1350, Slip Op. at 14 (U.S. April 30, 2007), citing *In re Khah*, 441 F.3d 997,998 (Fed. Cir. 2006).

Thus, for at least these reasons, independent claim 1 is patentable over the applied references. Additionally, claims 5-9 depend from claim 1 and are therefore also patentable over the applied references for at least the reasons enumerated above, as well as for the additional features they recite.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 5-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Aaron L. Webb
Registration No. 56,930

JAO:ALW/mog

Attachment:
Request for Continued Examination

Date: October 10, 2007

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--